

Appl. No. 09/580,305

Attorney Docket: P6484D2

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated March 2, 2006, in which:

- claims 1, 2, 8-15, 18-21, 23, 25, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba *et al.* (hereafter, 'Carrubba,' US Patent No. 5,629,866) in combination with Hjelsvold *et al.* (hereinafter 'Hjelsvold;' US Publication No. 2003/0145333 A1);
- claims 3-6 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba in combination with Hjelsvold , Wonfer *et al.* (hereinafter 'Wonfer;' US Patent No. 6,381,747, and Ellis *et al.* (hereinafter 'Ellis;' US Patent No. 6,357,043; and
- claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba in combination with Hjelsvold , and Hendricks *et al.* (hereinafter 'Hendricks;' US Patent No. 5,990,927).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 1 month(s), including the appropriate fee, is filed herewith.

Claims 1-6, 8-16, 18-21, and 23-26 are now pending the above referenced patent application. No claims have been amended, cancelled, or added. No new matter has been entered.

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1. 35 U.S.C. § 103(a)

1.1. Carrubba and Hjelsvold: Claims 1, 2, 8-15, 18-21, 23, 25, and 26

The PTO has also rejected claims 1, 2, 8-15, 18-21, 23, 25, and 26 under 35 U.S.C. § 103(a) based upon Carrubba in combination with Hjelsvold. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicants begins with claim 1. Claim 1 recites:

1. (Original) A method comprising:
receiving a selection to buy an upgraded media feature for a programming transmission;
automatically coordinating purchase of the upgraded media feature for the programming transmission; and
automatically coordinating provision of the upgraded media feature for the programming transmission.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Carrubba nor Hjelsvold, either alone or in combination, suggests or describes receiving a selection to buy an upgraded media feature for a

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programming transmission. The PTO asserts that Carrubba teaches this limitation. See, Carrubba column 1, lines 52-64. However, it is respectfully asserted that Carrubba does not teach this limitation.

Carrubba instead teaches an upgraded media feature for a program originating on CD-i Player. See Carruba Fig. 1, element 6 and col. 4, lines 13-20. Carruba shows the original program coming from the CD-i player and the complementary programming coming from a data source. A CD-i player is defined as:

CD-i (Compact Disc - interactive) is the multimedia CD format specified in 1986 (in the Green Book). CD-i was specified as an entire system, comprising not just a disc and data format, but a hardware and software system, a variety of special compression methods for audio and visual data, and a method of interleaving audio, video, and text data. Developed as a user-friendly alternative to a PC, CD-I players are easier to use, and have TV video output as well. Full screen motion video capabilities were added to the original specification later.

A CD-i player is a stand-alone system that includes a CPU, memory, and an integrated operating system. It can be connected to a TV set for displaying pictures and sound, or to a stereo system. The user interacts by positioning a cursor and selecting options, with a device such as a specialized remote control.

Although CD-i never realized broad commercial success, it is now used in education, training, and other professional applications.

(from WhatIs.Com on December 18, 2005 at http://searchstorage.techtarget.com/sDefinition/0,,sid5_gci503661,00.html)

In Applicants' claim 1, the original program is a "programming transmission." Carruba's original program is not transmitted. It is housed on a CD-i disc. See Carruba Figs 1, elements s1 & 6. Therefore, it is respectfully asserted that Carruba fails to meet the limitations of the claim for which it is put forth. The PTO does not assert that Hjelsvold ameliorates this deficiency. Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

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In the March 02, 2006 Office Action, the PTO states that Carruba does show a programming transmission at Carruba col. 1, line 65 – col 2, line 9, which reads (emphasis added):

An embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network.

Applicants admit that at first glance the PTO's arguments seem plausible; however it is respectfully asserted that upon further examination an error is evident. It is respectfully asserted that Carruba shows the "complementary part" being transmitted, not the "basic part". The "basic part" is stored locally. Applicants' claim 1 requires that the "basic part" be a "programming transmission". It is respectfully asserted that what Carruba is transmitting is not the "programming transmission" (*i.e.* basic part) but the "upgraded media feature" (*i.e.* complementary part) of Applicants claim. The PTO does not assert that Hjelsvold ameliorates this deficiency. Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 2, 8-15, 18-21, 23, 25, and 26 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

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1.2. Carrubba, Hjelsvold, Wonfer, and Ellis: Claims 3-6 and 16

The PTO has also rejected claims 3-6 and 16 under 35 U.S.C. § 103(a) on Carrubba in combination with Hjelsvold, Wonfer, and Ellis. The rejection of these claims is also traversed.

Applicant begins with claim 3. Claim 3 recites:

- 1 3. (Original) The method of claim 1 wherein the automatically coordinating the purchase of the
- 2 upgraded media feature comprises:
- 3 billing a client for services performed by a server system; and
- 4 providing billing information about the client to at least one of a plurality of
- 5 programming transmission sources that provided the programming transmission.

Claim 3 ultimately depends from the independent claim 1. Claim 1 recites:

- 1 1. (Original) A method comprising:
- 2 receiving a selection to buy an upgraded media feature for a programming transmission;
- 3 automatically coordinating purchase of the upgraded media feature for the programming
- 4 transmission; and
- 5 automatically coordinating provision of the upgraded media feature for the programming
- 6 transmission.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Carrubba, Hjelsvold, Wonfer, nor Ellis, either alone or in combination, suggests or describes receiving a selection to buy an upgraded media feature for a programming transmission. The PTO asserts that Carrubba teaches this limitation. See, Carrubba column 1, lines 52-64. However, it is respectfully asserted that Carrubba does not teach this limitation. See discussion above. The PTO does not assert that either Hjelsvold, Wonfer, or Ellis ameliorates this deficiency. Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce

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the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 4-6 and 16 either depend from and include the limitations of claim 3, or include a substantially similar and patentably distinct limitation as claim 3. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 3. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

1.3. Carrubba, Hjelsvold, and Hendricks: Claim 24

The PTO has also rejected claim 24 under 35 U.S.C. § 103(a) on Carrubba in combination with Hjelsvold and Hendricks. The rejection of this claim is also traversed.

Applicant begins with claim 24. Claim 24 recites:

- 1 24. (Original) The apparatus of claim 23 wherein the client system comprises:
2 an entertainment system to display the programming transmission with the upgraded
3 media feature; and
4 a user interface to provide a plurality of selection options to a user, said user interface to
5 receive the selection from the user.

Claim 24 ultimately depends from the independent claim 23. Claim 23 recites:

- 1 23. (Original) An apparatus comprising:
2 a client system to send a selection to a server system to buy an upgraded media feature
3 for a programming transmission, said client system to receive the programming with the upgraded
4 media feature.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Carrubba, Hjelsvold, nor Hendricks, either alone or in combination, suggests or describes buying an upgraded media feature for a programming

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transmission. The PTO asserts that Carrubba teaches this limitation. See, Carrubba column 1, lines 52-64. However, it is respectfully asserted that Carrubba does **not** teach this limitation. See discussion above. The PTO does not assert that either Hjelsvold or Hendricks ameliorates this deficiency. Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

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CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,

Dated: June 28, 2006

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